

REMARKS

Claims 1 – 20 were pending and claims 1, 2, 5, 9, 12-15, 18, and 20 are amended. New claims 21 – 27 have been added. Claims 1, 2, 5, 9, 12-15, 18, and 20 are amended to reflect judicial interpretation of the use of “at least one of” with respect to the conjunctive “and” as held in SuperGuide Corp. v. DirecTV Enter., Inc., 358 F.3d 870 (Fed. Cir. 2004). Support for the amendments and claims 21 – 23 is found throughout the specification, e.g., paragraphs 0042 - 0043 and 0062 – 0064, and FIGs. 3B – 3F. Support for new claim 24 is found in, for example, paragraph 0103. Support for new claim 25 is found in, for example, paragraph 0093. Support for new claim 26 is found in, for example, paragraph 0048. Support for new claim 27 is found in, for example, paragraphs 0100 and 0114. No new subject matter has been added.

In the Office action mailed on January 13, 2006, (hereinafter “the Office action”) claim 9 was rejected under 35 U.S.C. § 112, second paragraph for lack of antecedent basis for the limitation “the patient visit.” Also in the Office action, claims 1-8 and 13-20 were rejected under 35 U.S.C. § 102(e) as being unpatentable over Burks et al. United States Patent 6,453,297 (hereinafter known as “Burks”). Claims 9-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Burks in view of Berman et al. United States Patent 5,995,939, (hereinafter “Berman”). Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Burks in view of Ilsen et al. United States Patent 6,757,898 (hereinafter “Ilsen”). Applicants respectfully traverse these rejections and submit that Burks, Berman, or Ilsen, alone or in combination, fail to disclose each and every limitation of now pending claims 1 - 27.

An overview of the cited art is illustrative. Briefly, Burks teaches a medical transaction system for submitting claims to a transaction partner after a patient has visited a health care

provider. Berman discloses a fulfillment system where client computers at a healthcare provider email service requests directly to service providers, e.g., insurance companies, who then perform the requested service manually and then email the results back to the health care provider. Ilsen teaches a network system for doctors and patients to interact whereby patients are provided with personalized web pages.

As shown below, Burks, either alone or in combination with Berman or Ilsen, fails to disclose the limitations of claims 1 – 27.

Rejections under 35 U.S.C. § 102(e)

To anticipate a claim, the reference must teach every element of the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131.

Claim 1 was rejected under 35 U.S.C. 102(e) as unpatentable over Burks. In light of amended claim 1, Burks, either alone or in combination with Berman or Ilsen, fails to disclose a method for managing a medical practice comprising, among other features, *performing one or more automated patient workflow tasks associated with the event*.

The Office action states “[a]s per claim 1, Burks teaches a method for managing a medical practice.” The Applicants respectfully disagree. Burks does not disclose or teach, “managing a medical practice;” rather, Burks teaches “[a] medical transaction system... which is capable of permitting a plurality of healthcare providers to communication with a plurality of payors and financial institutions.” Burks, Abstract. Burks’ disclosure is limited to a claims processing system and does not teach a system for managing a medical practice. For example, Burks fails to teach or disclose automated patient workflow tasks (per amended claim 1). In fact,

Burks does not disclose or teach any patient-related workflow; rather, Burks teaches claims processing workflow. For example, in rejecting claim 1, the Office action cites Burks, Col. 6, lines 15 – 19 as evidence that Burks discloses, “performing one or more tasks associated with [an] event related to a patient.” However, both submissions disclosed in Burks are claim processing tasks, not automated patient workflow tasks. Automated patient workflow tasks may occur before, during, or after the event associated with the patient. The Office action acknowledges in rejecting claims 9 – 11 under 35 U.S.C. § 103 that Burks fails to explicitly disclose several contemplated embodiments of patient workflow tasks (the patentability of the claims under 35 U.S.C. § 103 is discussed below). January 13, 2006 Office action, page 7. Support for the amendments to claim 1 is found throughout the specification, e.g., paragraphs [0063] through [0068]. Claims 2 – 8, 13 – 14 depend from claim 1 and distinguish from Burks for at least the same reason.

In the Office action, claims 15 and 19 were rejected as being unpatentable over Burks for the same reasons as claim 1. Applicants respectfully submit that, as amended, claims 15 and 19 successfully traverse and overcome the respective rejections for the reasons above. Applicants respectfully submit that claims 16 – 18 depend from claim 15 and thus successfully overcome the rejection for the reasons above as well. Likewise, the Office action rejected claim 20 as being unpatentable over Burks for the same reasons as claim 1. Applicants respectfully submit that, as amended, claim 20 successfully traverses and overcomes the rejection for the reasons above.

Therefore the Applicant respectfully submits that, as amended, claims 1 – 23 overcome the prior rejection under 35 U.S.C. § 102(e).

Rejections under 35 U.S.C. § 103(a)

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.” MPEP § 2142. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.03. Thus, a combination of references must not merely be able to be combined, but there must be some suggestion in the references to combine them.

The Office action rejected claims 9 – 11 as unpatentable under 35 U.S.C. 103(a) over Burks in view of Berman. Specifically, the Office action rejected claim 9 as unpatentable stating that though Burks fails to explicitly disclose a method wherein the performing of the tasks before the event further comprises the steps of at least one of: receiving a request for an appointment, searching for the patient in a patient information database, receiving insurance information, receiving referral information, and receiving a proposed schedule appointment, it would have been obvious to one skilled in the art (as evidenced by Berman), to combine them. Applicants respectfully disagree.

The Office action cites Berman, Col. 4, lines 7 – 24 as an example. Berman's disclosure teaches an email-based system wherein personnel at the client site compose service requests and email them directly to the sponsors, upon which sponsors then receive the email messages in an

email inbox, perform the request manually, and then send a response email. To contrast, in the Applicants application, patient workflow is automated and not handled by clients systems, i.e., not handled by the medical care provider client 10. See Applicants' Specification, paragraphs [0058] and [0072], respectively. In addition to requiring manual fulfillment of emailed requests, Berman's disclosure specifically teaches that "[t]he present system requires that a database of information, such as identities of a roster of patients, be built up on the client system." Berman, Col. 3, lines 6 – 8. Further, the update tasks in Berman, Col. 7, line 23 – 25, and 44 – 49, cited by the Office action on page 8 of the Office action, refer to updating client-side databases with price lists. These tasks are handled client-side i.e., "[a]t step 203, client software 28 determines which type of message is present." Berman, Col. 7, lines 33 – 35. There is no motivation to combine Berman and Burks. To the contrary, Berman's client-side email processing teaches away from Burks' centralized claim processing.

As such, Applicants respectfully submit that there is neither motivation to combine the centralized claims processing-only system of Burks with Berman's client-side, sponsor-emailing system, nor does any such combination disclose or make obvious all the limitations of claim 9. Thus Applicants respectfully submit that amended claim 9 traverses and overcomes the Office action's rejection under 35 U.S.C. § 103(a). Because claims 10 and 11 depend from claim 9, Applicants submit that claims 10 and 11 are also allowable.

The Office action rejected claim 12 as unpatentable under 35 U.S.C. 103(a) over Burks in view of Ilsen. Specifically, the Office action states that though Burks fails to disclose a method wherein the tasks performed during the event further comprise at least one of performing check-in tasks and performing check-out tasks, it would have been obvious to one skilled in the art to

combine Burks with Ilsen which teaches check-in tasks and check-out tasks in Col. 13, lines 22 – 24. Applicants respectfully disagree. Ilsen teaches a network system for doctors and patients to interact whereby patients are provided with personalized web pages. As disclosed, Ilsen's system does not teach a method of practice management, rather it provides a web site for patients to interact with healthcare providers. Line 23 of Ilsen is illustrative: (after receiving a request for an appointment) *the practice scheduler uses the practice's normal scheduling software*. The Applicants' invention processes automated patient workflow tasks, e.g., scheduling, whereas Ilsen specifically defers to the practice's existing software. Thus, Ilsen discloses a website for patients to view appointments and interact with their healthcare provider. There is no motivation to combine Ilsen's patient-oriented website with Burks centralized claim processing system because neither provide nor teach, alone or in combination, the necessary automated patient workflow tasks, nor does any such combination disclose or make obvious all the limitations of claim 12. Thus Applicants respectfully submit that amended claim 12 traverses and overcomes the Office actions rejection under 35 U.S.C. § 103(a).

Rejections under 35 U.S.C. § 112

Claim 9, has also been amended with respect to Office action's rejection under 35 U.S.C. § 112, second paragraph and Applicants respectfully submit that claim 9 is in allowable form.

Summary

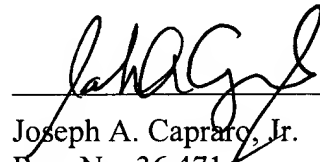
In view of the foregoing remarks and the inability of the prior art, alone or in combination, to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested.

It is also respectfully requested that, in order to expedite prosecution of this application, the undersigned be contacted at the telephone number indicated below before issuance of another Office action if the Examiner intends to apply a new prior art reference against the current claims. A fee sheet submitted with this Amendment and Response indicates the appropriate fee for the additional claims 21 - 27. Please apply any required charges or overpayment credits to deposit account 50-3081.

CONCLUSION

In view of all of the foregoing reasons, Applicants respectfully request reconsideration,

Respectfully submitted,



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